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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,892	06/18/2007	Markus Muller	075422-0020	2347
20277 7590 01/06/2009 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
CHUNDURU, SURYAPRABHA				
ART UNIT		PAPER NUMBER		
1637				
MAIL DATE		DELIVERY MODE		
01/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,892

**Applicant(s)**

MULLER ET AL.

**Examiner**

Suryaprabha Chunduru

**Art Unit**

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The Applicants' response to the office action field on September 17, 2008 has been considered and acknowledged.

***Status of the application***

2. Currently claims 1-20 are pending under examination. Claims 21-22 were cancelled.

Applicants' arguments and the amendment have been fully considered and deemed persuasive in-part for the reasons that follow.

***Response to arguments:***

3. With regard to the objection to the abstract, Applicants' arguments and the amendment were fully considered and found persuasive. The objection is withdrawn herein in view of the amendment.

4. With regard to the informalities, Applicants' arguments and the amendment were fully considered and found persuasive. The objection to the informalities is withdrawn herein in view of the amendment.

5. With regard to the rejection of claims 8-11, 18-19, 21-22 under 35 USC 112, second paragraph, Applicants' arguments were fully considered and the rejection is withdrawn herein in view of the amendment.

6. With regard to the rejection of claims 1-2, 11-15, 17, 19-22 under 35 USC 102 (b) as being anticipated by Thatcher et al., Applicants' arguments were fully considered and found unpersuasive. Applicants argue that Thatcher et al. does not teach concentration of alkali salt as claimed the claim 1 step d). Applicants' arguments were found unpersuasive because the cited

col. 16, line 54-55 does teach the alkali salt (sodium chloride) concentration ranging from 1000mM to 1500mM, which is within the range of 1300mM or higher as claimed in step d) of the instant claim 1. Applicants also argue that the pH of the solution used is 8.0 which is not within the range of pH as claimed in the instant claim 1. Applicants' arguments were found unpersuasive because Applicants arguments were based on a portion of the patent which teaches a concentration of alkali salt and corresponding pH of the solution. However, the patent as a whole teaches a range of alkali salt between 1M to 1.5M and pH varies between 5 to 8.0 as claimed, thus the range of alkali salt and the pH are within the range as claimed in claim 1. Accordingly the rejection is maintained.

7. With regard to the rejection of claims 1-15, 17-22 under 35 USC 102(b) as being anticipated by Aberin, Applicants' arguments were fully considered and found unpersuasive. Applicants argue that Aberin does not teach the conductivity of the binding buffer as required by the instant claim 1. Applicants' arguments were found unpersuasive because Aberin teaches the concentration of alkali salt as required by the claim 1 in step a), thus the conductivity is an inherent property of said alkali salt having said concentration range. Accordingly Aberin does anticipate the claim 1. Applicants also argue that Aberin does not teach alkali salt concentration as claimed in claim 1. Applicants' arguments were found unpersuasive because Aberin does teach the concentration of alkali salt as claimed (see at least col. 3, line 11-13). Accordingly the rejection of claims 1-15, 17-20 is maintained.

8. With regard to the rejection of claim 16 under 35 USC 103(a) as being unpatentable over Thatcher et al. in view of Colpan et al., Applicants' arguments were fully considered and found unpersuasive. Applicants argue that Thatcher et al. fails to teach limitations as required by the

independent claim 1 and Colpan et al. does not cure the deficiencies of Thatcher et al.

Applicants' arguments were found unpersuasive because examiner notes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, specific motivation is provided in the rejection, which states that it would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made, to combine the method as taught by Thatcher et al. with the step of preparation of stationary phase as prepared by Colpan et al. to achieve expected advantage of developing an improved and sensitive nucleic acid isolation method because method of preparing stationary phase as taught by Colpan et al. would result in efficient separation of plasmid DNA with depleted endotoxin (see col. 7, line 9-67, col. 4, line 60-67, col. 5, line 1-67) and such a modification is considered obvious over the cited prior art. Accordingly the rejection is maintained.

### ***Conclusion***

No claims are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637